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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,914	08/13/2001	Alexander Kalnitsky	07927-033001/ MAXIM-279	8064

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EXAMINER

TOLEDO, FERNANDO L

ART UNIT PAPER NUMBER

2823

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,914

Applicant(s)

KALNITSKY ET AL.

Examiner

Fernando Toledo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 7, 8 – 10, 14, 15, 17 and 20 – 23 rejected under 35 U.S.C. 102(b) as being anticipated by Isaac et al. (U. S. patent 4,483,726).

In re claims 1 and 9; Isaac in the U. S. patent 4,483,726; figures 1 – 2-6, discloses forming a first polysilicon layer (18 and 32) within the emitter window on at least the base region (16); forming an interfacial oxide (20 and 20-1) in an upper portion of the first polysilicon layer and forming a second polysilicon layer (30) on the interfacial oxide layer.

3. In re claims 2 and 10, Isaac discloses wherein the emitter window is approximately 0.1 to 0.2 μm (column 2).

4. In re claim 4, Isaac teaches wherein the interfacial oxide layer is formed by exposing oxygen to the first polysilicon layer and annealing (figures 2-4 to 2-6).

5. In re claim 7, Isaac discloses wherein forming the second polysilicon layer includes ion-implanting dopants into the second polysilicon layer (column 3).

6. In re claim 8, Isaac shows further including after forming the second polysilicon layer to diffuse dopants from the polysilicon emitter and into the base region (column 3).

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7. In re claims 14 and 22, Isaac discloses forming a collector (26) within a substrate (10); forming a base region (16) on the collector region; forming an emitter dielectric layer (14) on the base region; forming an opening through the emitter dielectric layer to form an emitter window exposing a portion of the base region (figure 1); forming a first polysilicon layer (18 and 32) within the emitter window on at least the exposed base region; forming an interfacial oxide layer (20 and 20-1) in an upper portion of the first polysilicon layer; and forming a second polysilicon layer (30) on the interfacial oxide layer.

8. In re claims 15 and 23, Isaac discloses wherein the emitter window is approximately 0.1 to 0.2 μm (column 2).

9. In re claim 17, Isaac teaches wherein the interfacial oxide layer is formed by exposing oxygen to the first polysilicon layer and annealing (figures 2-4 to 2-6).

10. In re claim 20, Isaac teaches wherein forming the second polysilicon layer includes ion-implanting dopants into the second polysilicon layer (column 3).

11. In re claim 21, Isaac shows further including annealing after forming the second polysilicon layer (column 3).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 5, 6, 11 – 13, 16, 18 and 19 and 24 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isaac.

In re claims 3, 5, 6, 11 – 13, 16, 18 and 19 and 24 – 26 Isaac does not teach that the first polysilicon layer is 30 to 100 Å thick, or that the interfacial oxide layer has a thickness of 5 to 50 Å, or that the second polysilicon layer is of 500 to 5,000 Å thick.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to since thickness is a process variable and finding the optimum or workable ranges of the thickness of a layer requires only routine experimentation by someone of ordinary skill in the art. Note that the specification contains no disclosure of either the critical nature of the claimed thicknesses or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen thicknesses or upon another variable recited in a claim, the Applicant must show that the chosen thicknesses are critical. *In re Woodruf*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Response to Arguments

14. Applicant's arguments filed 19 May 2003 have been fully considered but they are not persuasive for the following reasons.

15. Applicant contests that forming an interfacial oxide layer in an upper portion of the first polysilicon layer is not disclosed, taught or suggested by the cited prior art.

Applicant further adds the following:

FIG. 1 of the Isaac patent shows a second insulation layer 20 disposed on polysilicon layer 18. However, forming layer 20 is not equivalent to "forming an interfacial oxide layer in an upper portion of the first polysilicon layer" as recited in claim 1 of the present application. For instance, layer 20 is a silicon dioxide layer and not an "oxide layer" as recited in claim 1 of the present application. As it is known in the art (as explained in the present application), to produce an

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oxide layer requires bleeding of oxygen. Moreover, layer 20 is disposed on layer 18 and not formed "in an upper portion of the first polysilicon layer" as recited in claim 1 of the present application.

Examiner respectfully submits that silicon dioxide, is an oxide since it contains a metalloid element (Si) and two oxygen atoms, hence the prefix "di". Furthermore, Isaac discloses that layer 20 can also be alumina (Al_2O_3), which is also an oxide. Therefore, Isaac discloses the limitation of forming an interfacial oxide layer. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See *also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

Also, layer 20 is formed on top of polysilicon layer 18, which includes forming the oxide layer in a portion of it as well. A portion can be interpreted as being the entire surface. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude

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additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.* 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)(“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”).

The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)(“consisting of” defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.”). Transitional phrases such as “composed of,” “having,” or “being” must be interpreted in light of the specification to determine whether open or closed claim language is intended. See, e.g., *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1573, 43 USPQ2d 1398, 1410 (Fed. Cir. 1997), cert. denied, 118 S. Ct. 1548 (1998)(In the context of a cDNA having a sequence coding for human PI, the term “having” still permitted inclusion of other moieties.). A claim which depends from a claim which “consists of” the recited elements or steps cannot add an element or step.

When the phrase “consists of” appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986).

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In *re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)(Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid “consisting essentially of” certain components. In finding the claims did not exclude the prior art ispersant, the court noted that appellants’ specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). “A consisting essentially of’ claim occupies a middle ground between closed claims that are written in a consisting of’ format and fully open claims that are drafted in a comprising’ format.” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder Co. v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. v. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For search and examination purposes, absent a clear indication in the specification of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ at 1355 (“PPG could have defined the scope of the

phrase consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."'). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989)("Although consisting essentially of' is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an applicant's burden to establish that a step practiced in a prior art method is excluded from his claims by 'consisting essentially of' language."').

16. Applicant also contests that the present application addresses problems with grain size and how it affects the size of the transistor.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., grain size on how it affects the size of the transistor) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

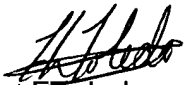
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fernando Toledo whose telephone number is 703-305-0567. The examiner can normally be reached on Mon-Fri 8am to 4pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7382 for regular communications and 703-308-7382 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



F Toledo
June 3, 2003



George Fourson
Primary Examiner
Art Unit 2823